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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,674	03/03/2004	Gina Parmar	016778-0474	2300

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
LE, DANH C	

ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/790,674	PARMAR ET AL.	
	Examiner	Art Unit	
	DANH C. LE	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,8,13,15,17,18,20,21,23,24 and 26-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,8,13,15,17,18,20,21,23,24 and 26-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. **Claims 1-4, 7, 8, 17, 20, 22, 23, 28, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi (US 6,377,804) in view of Ray (US 6,424,638).**

As to claim 1, Lintulampi teaches a method of establishing Universal Mobile Telecommunications System (UMTS) communication between User Equipment (UE) and a UMTS network (figure 4a, 5a), wherein

the User Equipment is in communication with a Global System for Mobile communication (GSM)-type network (figure 4A-B and 5A-B), the method comprising:

forwarding UMTS Terrestrial Radio Access Network (UTRAN) parameter transparently to the User Equipment via the GSM-type network (figure 4a, UMTS-RAN sends A-HOAck to MS or figure 5a, UMTS SGSN sends MM-RA-updateAccepted to the MS) ; and

in the User Equipment, interpreting the UTRAN parameters and initiating communication with the UMTS network.

Switching communication with the EU from the GSM-type network to the UMTS network.

Wherein the UTRAN parameters comprises bit transmission rate, bit error rate and transmission delay to the UE.

Lintulampi fails to teach a list of at least on node. Ray teaches a list of at least one node (col.5, lines 32-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of a system as Ray suggested.

As to claim 2, Lintulampi teaches the method according to claim 1, wherein the UTRAN parameter supplied by a Radio Network Controller of the UMTS network (col.2, lines 37-49).

As to claim 3, Lintulampi teaches the method according to claim 1, wherein the UTRAN parameter comprises a list of potential UTRAN access points (col.2, lines 37-49).

As to claim 4, Lintulampi teaches a method according to claim 1, wherein the UE is arranged to establish a link through the Radio Network Controller (RNC) of the UMTS network to the MSC of the GSM-type network (table 5A and 5B, MM-RA-updatedaccepted path).

As to claim 7, the claim is a mean for function claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 8, Lintulampi teaches a message or data packet in a GSM-tvpe network containing UTRAN parameters for handing over a GSM call to a UMTS network

to User Equipment engaged in a GSM call and capable of switching to a UMTS call (figures 5A and 5B).

Handover the GSM call from the GSM type network to the UMTS network.

Lintulampi fails to teach a list of at least on potential node. Ray teaches a list of at least one potential node (col.5, lines 32-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of a system as Ray suggested.

As to claim 17, the claim is a system claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 20, the claim is an apparatus claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 23, Lintulampi teaches a Radio Network Controller (figure 2, elements 5, 7 , figures 4, 5 and their descriptions), comprising:

means for generating the Universal Mobile Telecommunications System (UMTS) Terrestrial Radio Access Network (UTRAN) parameters;

means for forwarding the UTRAN parameters, via the Global System for Mobile communication (GSM)-type network, transparently to the User Equipment (UE) which communicates with the GSM-type network,

Switching communication with the EU from the GSM-type network to the UMTS network.

whereby the UE interpretes the UTRAN parameters and initiates communication with the UMTS network.

Lintulampi fails to teach a list of at least on potential node. Ray teaches a list of at least one potential node (col.5, lines 32-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of a system as Ray suggested.

AS to claim 28, the combination of Lintulampi and Ray teaches the method according to claim 1, wherein the UTRAN parameter information includes one or more of data rate, call type or quality service (transmission rate).

As to claim 32, the limitation of the claim is the same limitation of claim 28; therefore, the claim is interpreted and rejected as set forth as claim 28.

2. Claims 5 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi and Ray in view of Le (US 6,556,820).

As to claim 5, Lintulampi and Ray teaches a method according to claim 1, Lintulampi and Ray fails to teach the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links. Le teaches the potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links (col.13. lines 2-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Le into the system of Lintulampi and Ray in order to update on a dynamic basis.

As to claim 30, the combination of Lintulampi and Ray and Le teaches further comprises the UTRAN parameter information output from the UMTS network tunnel through the GSM type network without being interpreted or processed in any matter by the GSM type network (Le, figure 8, 810).

3. **Claims 13, 15, 18, 21, 24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi in view of Rinne (US 2001/0046863)**

As to claim 13, Lintulampi teaches the method according to claim 1, Lintulampi fails to teach the parameters include one or more of Downlink (DL) channelization code, Uplink (UL) spreading factor, Uplink (UL) scrambling code, Radio Frequency, Radio Link ID, Link Reference, S-RNTI, Transport Format Sets, Transport Format Combination Set and Initial DL Power. Rinne teaches the parameters include one or more of Downlink (DL) channelization code, Uplink (UL) spreading factor, Uplink (UL) scrambling code, Radio Frequency, Radio Link ID, Link Reference, S-RNTI, Transport Format Sets, Transport Format Combination Set and Initial DL Power (paragraph 195, 198). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rinne into the system of Lintulampi in order to enhance the system performance of the mobile communication system.

As to claim 15, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 18, the claim is a system claim of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 21, the claim is an apparatus claim of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 24, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

As to claim 26, the limitation of the claim is the same limitation of claim 13; therefore, the claim is interpreted and rejected as set forth as claim 13.

4. **Claims 27, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi (US 6,377,804) and (US 6,014,565) in view of Tiedemann (US 6,216,004).**

As to claim 27, the combination of Lintulampi and Ray teaches the method according to claim 1, further comprising switching directly form a mode in which UE is in communication with a GSM base station to a UMTS mode. The combination fails to teach a diversity mode in which the UE is in communication with a plurality of base station access nodes. Tiedemann teaches a diversity mode in which the UE is in communication with a plurality of base station access nodes (col.14, lines 50-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tiedemann into the system of Lintulampi in order to enhance the performance of the mobile communication system.

As to claim 31, the limitation of the claim is the same limitation of claim 27; therefore, the claim is interpreted and rejected as set forth as claim 27.

5. **Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi (US 6,377,804) and (US 6,014,565) in view of Burns (US 7,200,110).**

As to claim 29, the combination of Lintulampi and Ray teaches the method according to claim 1, which generating a list of one or more available links for the UE; Lintulampi and Ray fails to teach deleting, for the list of one or more available links, links on which satisfactory communication is not possible, to obtain an updated list of one or more available links; and supplying the updated list of one or more available links to the UE. Burns teaches deleting, for the list of one or more available links, links on which satisfactory communication is not possible, to obtain an updated list of one or more available links; and supplying the updated list of one or more available links to the UE (col.14, lines 44-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Burns into the system of Lintulampi and Ray in order to enhance the performance of the mobile communication system.

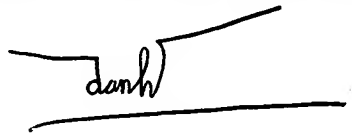
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Cjaza (US 2002/0037726) teaches forward link... CDMA system.Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



December 17, 2007
DANH LE
PRIMARY EXAMINER